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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,501	09/14/2000	Kimiko Watanabe	SAIKP0113US	9901
7590	12/28/2004		EXAMINER	
Neil A DuChez RENNER, OTTO, BOISSELLE & SKLAR, P.L.L. Nineteenth Floor 1621 Euclid Avenue Cleveland, OH 44115			GRANT II, JEROME	
			ART UNIT	PAPER NUMBER
			2626	
DATE MAILED: 12/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	<b>Applicant(s)</b>	
	09/662,501	WATANABE ET AL.	
	Examiner	Art Unit	
	Jerome Grant II	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 September 2004.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

Detailed Action

1.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, line 11, and the throughout the claims, applicant refers to facsimile and other modes. The term other modes is vague and indefinite. Other than a fax mode any other modes have not been specifically set forth. Could applicant be referring to other modes than that described in the specification ?

2.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Neither the written specification nor the drawings provides support for the complex image processing means being a stand alone apparatus..

3.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 7-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato.

With respect to claim 1, Kato teaches a complex image processing apparatus (shown by figures 2 and 6) capable of operating as a facsimile apparatus, comprising: An image reading means 42 for reading information from a document; an image communicating means (modem 11 and NCU 5) for transmitting the image information read by the image reading means 42 and receiving image data; image forming means (printer 18) for recording the image information as claimed; mode switching means (switchboard 7 or PC 8) for carrying out switching among the fax mode and other modes (PC mode). Kato teaches the complex image processing apparatus being used in a fax mode in which image data can be received. Kato teaches a fax memory according to col. 9, lines 29-48 as claimed. Kato teaches a PC memory according to col. 9, lines 7-9 and 60-65 regarding the mode other than a fax mode. Kato teaches a memory control means (ROM 13) for performing control in the fax mode such that image information stored in the memory for fax is transferred to either or both of the memories for the other

modes in the case where predetermined conditions are satisfied. Note col. 10, lines 6-21 where data which cannot be stored in the fax memory is transferred and stored in the PC memory. *Note, with respect to the new limitation added by amendment, i.e., each of the modes involving recording image information on a recording medium, the fax reproduces an image on a recording medium, such as a sheet of recording paper. The other mode, referred to as the PC, records image data on a memory means. The memory means is the means for recording data.*

With respect to claim 3, see col. 10, lines 6-21 where Kato teaches that when the memory in the fax is full, data is sent to the PC memory as the predetermined condition.

With respect to claim 5, Kato teaches transfer to memory when rearranged according to another criteria. According to Kato, the other criteria is the availability of memory space in the fax memory according to col. 10, lines 6-21.

With respect to claim 7, this limitation is inherent since no other conversions or formats are discussed when the fax memory is full and excess data is sent to the PC memory according to col. 10, lines 6-20.

With respect to claim 8, Kato teaches the memory for the fax (fax memory according to col. 9, lines 29-48) and PC memory is controlled by a control memory CPU 10/switch 7 or PC 8 which controls such that the image forming means records image information stored in the memory of the other mode (PC mode), on a recording medium (memory of the PC) prior to recording the image information stored in the memory of the fax.

With respect to claim 9, Kato teaches wherein the case where received image information is stored in the memory for fax (fax memory according to col. 9, lines 29-48) and in either the other modes (PC memory mode) the memory control means performs control such that the image forming means records image information stored in the memory for fax (fax memory ) on a recording medium (content of the memory) prior to the recording of information on the PC memory (see col. 10, lines 6-20)

With respect to claim 11, Kato teaches the complex image processing apparatus 1, as shown in figure 2, is a stand alone apparatus. It stands alone from the fax as well as the PC.

4.

Claims 2, 4, 6 and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

5. **Examiner's Remarks**

At the bottom of page 5, applicant has reviewed the applicant's remarks. The remarks, however, are not persuasive to allow the claims. The examiner opines that "other modes" remains an indefinite term. It is also found in the written specification. Applicant could technically be referring to modes other than that disclosed. Other modes does not enable one of ordinary skill in the art to make the invention. At page 8 of the argument, applicant contends that there is no image information stored in the memory for facsimile which is transferred to either or both of the memories for the other modes. The applicant's contention is respectfully traversed. Kato clearly teaches in the Tenth paragraph that

"The image data received from the remote facsimile machine and dot data for generating print outputs are stored in an image memory 19 which may be a dynamic RAM (DRAM). In a normal fax reception operation in which fax transmission and reception are taken place at a real time, the image data is received after exchanging signals according to a predetermined communication control sequence between the called facsimile machine 1 and the calling facsimile machine 9 or personal computer 8. The image data is temporarily stored in the buffer memory 12 in the form of an analog signal. The image data stored therein is decoded (expanded) by the decoder 20. The resultant data is developed into a dot image and written into the bit image storing area of the image memory 19 so as to print the image on a page basis. The dot image stored in the image memory 19 is developed into bits of a predetermined resolution and the resultant data is sent to the printer 18 for printing on a page basis."

Hence, the data stored in the fax may be transferred to either a printer 18 or a PC

8. In the second full paragraph of page 9, applicant argues that the switchboard could not perform the function of controlling either of the two modes. But applicant does not provide a rationale as to why the switchboard 7 could not serve as the means. Applicant's argument here appears to be only an allegation.

6.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams, can be reached on 703- 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Grant II